

## REMARKS

The last Office Action has been carefully considered.

It is noted that Claim 9 is rejected under 35 USC 102(b) by the U.S. patent to Davidson.

Claims 1, 3, 5 and 11 are rejected under 35 USC 103(a) over the patent to Davidson in view of the U.S. patent to Powers.

Claims 4, 6-8 and 10 are rejected under 35 USC 103(a) over the U.S. Patent to Davidson in view of the U.S. patents to Powers and Jameson.

Claim 12 is rejected under 35 USC 103(a) over the U.S. Patent to Davidson in view of the patents to Powers and Hofelt ??.

Claim 13 is rejected under 35 USC 103(a) over the U.S. Patent to Davidson in view of the U.S. Patents to Powers, Oppelt and Meilli.

After carefully considering the Examiner's grounds for rejection of the claims over the art, applicants amended Claims 1, 9 and 11, the broadest independent claims currently on file, to more clearly define the present invention and to distinguish it from the prior art.

It is respectfully submitted that the new features of the present invention as defined in the amended independent claims are not disclosed in the references and cannot be derived from them as a matter of obviousness.

The independent claims currently on file define a fire alarm having a flush-mounted installation outlet for installation in a sealing, a base connected with the flush-mounted installation outlet, a fire alarm insert connected to the base and carrying a radiation receiver and radiation transmitter, a covering cap, and a sheet spaced from the base and located between the covering cap and the fire alarm insert to cover the latter, with the covering cap being transparent to expose the color of the sheet or sheets.

Turning now to the references applied by the Examiner against the original claims, and in particular to the U.S. patent to Davidson, it can be seen that this reference is used a modular interchangeable cover system. The Examiner identified the component 29

as a sheet. It is respectfully submitted that the component 29 is not a sheet, but instead, as specifically disclosed in this reference, is a thick adaptor plate provided with protruding screw-receiving barrels (38, 39); (70a, 72a), a protruding inner wall (108), and a protruding circumferential outer wall. Definitely, the outlet component (29) can be considered as a sheet of the fire alarm as in the present invention.

Also, as can be seen from the patent to Davidson, the base (46) of the device disclosed in this reference is inserted into the inner opening of the component (29), while to the contrary, as defined in the claims, the sheet (2, 2.1) of the fire alarm system in accordance with the present invention is spaced from the base (1.5).

The independent claims also define that the fire alarm which is connected to the base (1.5) and located between the base and sheet (2, 2.1) carries a radiation receiver and a radiation transmitter.

These features are not disclosed in the references.

As for the Examiner's rejection of Claim 9 over this reference as being anticipated, it is believed to be advisable to cite the decision In Re: Lindenmann Maschinenfabrik GmbH v. American Hoist & Derrick Co., 221 USPQ 481, 485 (Fed. Cir 1984) in which it was stated:

“Anticipation requires the presence in a single prior art reference disclosure of each and every element of the claimed invention, arranged as in the claim.”

Definitely, the patent to Davidson does not disclose each and every element of the present invention as now defined in the amended independent claims, and therefore the anticipation rejection based on the patent to Davidson should be considered as not tenable with respect to the independent claims and should be withdrawn.

The other references applied by the Examiner in combination with the patent to Davidson also do now disclose the above mentioned new features of the present invention as defined now in the independent claims. In order to arrive at the present invention provided with the above-listed new features from the references it does not suffice to use the teaching of the references, but the references have to be fundamentally modified by including into them the new features of the present invention which are now defined in the amended independent claims and which were first proposed by the applicants. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *In Re Randol and Redford* (165 USPQ 586) that:

Prior patents are references only for what they clearly disclose or suggest, it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

It is therefore respectfully submitted that the present invention which includes the above-specified new features cannot be considered as obvious from the combination of the references, and the independent claims should be considered as patentably distinguishing over the references and should be allowed.

The Examiners attention is respectfully directed to the features of Claim 12. This claim specifically defines that the transmitter and the receiver are arranged on the insert (1.1) such that a scattering point is located outside a light scattering small detector. The references do not disclose the transmitter or receiver arranged on the insert connected to the base in the fire alarm system so that a scattering point is located outside the light scattering small detector.

Claim 14 additionally defines that the transmitter and the receiver arranged on the insert (1.1) extends through the sheet (2) to the

transparent power cap (3). These features are also not disclosed in the references.

It is therefore respectfully submitted that Claims 12 and 14 should also be considered as patentably distinguishing over the art and should also be allowed.

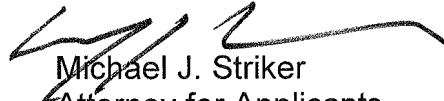
As for the other dependent claims, these claims depend on corresponding independent claims, they share their allowable features, and they should be allowed as well.

Reconsideration and allowance of the present application with all the claims currently on file is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be

helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,



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